REMARKS

In the Office Action, dated June 8, 2005, the Examiner has rejected claims 1-20. After the present response, claims 1-20 are pending in the application. Reconsideration and allowance of pending claims 1-20 in view of the following remarks are respectfully requested.

A.   Rejection of Claims 1-20 under the Judicially Created Doctrine of Double Patenting

The Examiner has rejected claims 1-20 under the judicially created doctrine of double patenting, as being unpatentable over claims 1-27 of Kerner, et al. (USPN 6,731,726) ("Kerner") in view of Terschluse (USPN 6,118,857) ("Terschluse"). Applicant respectfully disagrees.

Applicant respectfully traverses Examiner's double patenting rejection, because the present application and Kerner do not have a common inventor, and the present application is presently assigned to Silicon Laboratories, Inc., whereas Kerner is owned by Conexant Systems, Inc.

Further, although the Examiner acknowledges that claims 1-27 of Kerner fail to disclose, teach or suggest an in-band caller identification request, an in-band caller identification message or an in-band answer request, which are embedded in a data stream being communicated between the local modem and the host, the Examiner asserts that Terschluse teaches such limitations and that Terschluse can be combined with Kerner to render obvious claims 1-20 of the present application. Applicant respectfully disagrees.

The Examiner states that "Terschluse teaches a data transmission method having special signals, i.e., call-waiting signal or caller identification signal, that are contained in a received signal, such that special signals are embedded in a data stream being communicated, in order

Page 9 of 14

01CXT0032C

prevent disturbance to a data connection at a modem as a calling waiting signal being arrived while data connection taking place (col. 6 lines 44-46.)" First, applicant notes that the cited portion of Terschluse is a part of claim 1 of Terschluse, which reads: "a signal detection device connected to said subscriber connection for detecting a special signal contained in the received signal." Therefore, there is no reference in the cited portion of Terschluse to an in-band caller identification request, an in-band caller identification message or an in-band answer request, which are embedded in a data stream being communicated between the local modem and the host. In fact, the cited portion of Terschluse has no relevance to the above-recited limitation of claim 1 of the present application. The signal detection device 6 of Terschluse, which is shown in FIG. 1, detects the presence of a call-waiting signal that is provided by DAA 18. As shown in FIG. 1, the signal provided to the detection device 6 is a modulated signal, because the signal has not passed through the demodulator 5 for demodulation yet. Since the demodulator 5 generates the data stream, the signal received by the detection device 6 is not a data stream.

Furthermore, even if the Examiner were to interpret the signal that is received by the detection device 6 as the data stream (which is even against the teaching of Terschluse that refers to connections 2a and 2b as data connections), Terschluse clearly states that when the detection device 6 detects a call-waiting signal, the compensation device 7 removes the call-waiting signal that is contained in the received signal prior to passing the signal to the demodulator 5. Because of such removal, "the data stream being communicated between the local modem and the host" via data connection 2a would not have "an in-band caller identification request, an in-band caller identification message or an in-band answer request" embedded therein. (See col. 4, lines 33-65.)

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Even more importantly, Terschluse indeed states that when a special signal is detected, the connection controller 14 communicates such signal to the PC 15 via connection 2b, which is shown in FIG. 1, as a distinct terminal from connection 2a that communicates the data stream to the PC 15. Therefore, Terschluse teaches that "the data stream being communicated between the local modem and the host," at connection 2a in FIG. 1, does not include "an in-band caller identification request, an in-band caller identification message or an in-band answer request" embedded therein, rather, any special signal is independently communicated via data connection 2b.

Accordingly, applicant respectfully submits that claims independent 1, 8 and 14, and their respective dependent claims 2-7, 9-13 and 15-20 are patentably distinguishable over Kerner in view of Terschluse.

B.   Rejection of Claims 1-6 and 8-19 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 and 8-19, under 35 U.S.C. § 103(a), as being unpatentable over Civanlar, et al. (EP 0741481 A2) ("Civanlar") in view DePont, et al. (USPN 6,317,488) ("DePont") and Terschluse.

The Examiner acknowledges that Civanlar fails to disclose, teach or suggest "receiving an in-band caller identification request from said host for said caller identification; transmitting said caller identification to said host using an in-band caller identification message; and receiving an in-band answer request from said host to answer said incoming call." However, the Examiner states that DePont discloses such limitations at Col. 2, line 39 through Col. 3, line 22. Applicant

01CXT0032C

respectfully disagrees. Applicant respectfully submits that DePont fails to disclose, teach or

suggest such limitations. In fact, DePont states as follows:

> The ICM 12 acknowledges the detected CAS tone 62 by generating a
> particular DTMF tones from signal generator 27 in block 82. The DTMF
> acknowledgement notifies the CO switch 18 to send down Caller ID
> information 64. In one example, the Caller ID information 64 is sent using
> Frequency Shift Keying (FSK) signaling. The Caller ID information 64 is
> received by the ICM 12 and then output on display 28 in block 84. The
> modem 56 is then reconnected to the telephone line 49 by the controller 20
> by directing switch 34 back into position 36 in block 86. (Col. 3, lines 13-
> 22.)

Applicant respectfully submits that DePont does not disclose anything about an in-band

caller identification request, an in-band caller identification message or an in-band answer

request. DePont simply states that the Caller ID information 64 is received by the ICM and then

output on display in block 84.

Further, for the reasons stated above, applicant respectfully submits that Terschluse fails

to disclose, teach or suggest "wherein said in-band caller identification request, said in-band

caller identification message and said in-band answer request are embedded in a data stream

being communicated between said local modem and said host," as recited in independent claims

1, 8 and 14. As a result of utilizing in-band commands and status messages to communicate a

modem interruption event to the DTE, the process is performed more efficiently and without

interruption of the data flow between the local modem and the remote modem. In addition, the

present invention provides a user-transparent modem interruption communications between the

DCE and the DTE. Accordingly, independent claims 1, 8 and 14 are patentably distinguishable

over the cited references.

Page 12 of 14

01CXT0032C

Furthermore, dependent claims 2-6, 9-13 and 15-19 should also be allowed at least for the same reasons claims 1, 8 and 14 are patentably distinguishable over the cited references. As examples, claims 5, 12 and 18 recite "step of informing uses an RS232 ring signal or a 16550 ring signal to inform said host of said alert signal." It is respectfully submitted that the cited references fail to disclose, teach or suggest that an RS232 ring signal or a 16550 ring signal is used to inform the host of the alert signal while the local modem is in communication with the remote modem. As further examples, claims 6, 13 and 19 recite "step of informing uses an in-band ring message to inform said host of said alert signal, wherein said in-band ring message is embedded in said data stream being communicated between said local modem and said host." However, the cited references fail to disclose, teach or suggest that an in-band ring message is used to inform the host of the alert signal while the local modem is in communication with the remote modem.

Accordingly, it is respectfully submitted that claims 1-6 and 8-19 should be allowed.

C.   Rejection of Claims 7 and 20 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 7 and 20, under 35 U.S.C. § 103(a), as being unpatentable over Civanlar in view DePont and Terschluse, and further in view of O'Horo, et al. (USPN 5,519,767) ("O'Horo").

It is respectfully submitted that claims 7 and 20, depend from claims 1 and 14, respectively and, thus, claims 7 and 20 should be allowed at least for the same reasons stated above in conjunction with patentability of claims 1 and 14.

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D.   Conclusion
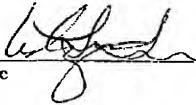
For all the foregoing reasons, an early allowance of claims 1-20 pending in the present

application is respectfully requested. The Examiner is invited to contact the undersigned for any

questions.

Respectfully Submitted;
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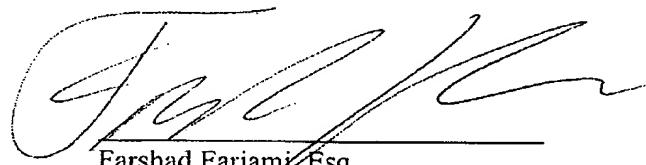
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